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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,358	08/02/2001	Tomoharu Kurita	212865	6028

23460 7590 09/05/2003

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6780

EXAMINER
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KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/05/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/921,358	KURITA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin R Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on July 8, 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-5,7, 9-16 and 18--26 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5,7 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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**DETAILED ACTION**

***Election/Restriction***

1. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected process of making a metal-clad laminate, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Applicant argues that the examiner has failed to establish that searching all the claims would be a "serious burden" to the examiner. The examiner respectfully disagrees. Specifically, searching the method claims would require a search of class 427, which is not required for the product.

This application contains claims are 9-16 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of claims 1-5, 7, 8, and 18 under 35 U.S.C. 102(b) as being anticipated by Numata et al (US 4,792,476) has been overcome by argument. The polymer taught in Numata does not read on the claimed polymer.
4. Claims 1-5, 7, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmura et al (US 4,377,652) in view of Akahoshi (US 4,970,107) for reasons of record.

***Claim Rejections - 35 USC § 103***

5. Claims 1-5, 7 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al (US 3,936,575) in view of Frost (US 3,984,375) and Akahoshi (US 4,970,107) for reasons of record.

With respect to claims 19-26, the examiner takes the position that Frost teaches the claimed polymer of formula (II) (see col 1, lines 30-35 wherein the R group is selected from the aromatics at col 2, lines 25-30).

***Response to Arguments***

Applicant's arguments filed July 9, 2003 have been fully considered but they are not persuasive.

Applicant argues that Ohmura does not employ crosslinking. The examiner respectfully disagrees. Ohmura states that crosslinking occurs above 150°C (col 5, lines 14+), but that the composition may be shaped, molded and bonded at temperatures up to 300°C (col 8, lines 38+). Furthermore, the compositions are subjected to temperatures of 400°C (see examples) that would inherently lead to crosslinking.

Applicant argues that the drying temperatures of Ohmura are too low to result in the claimed invention. However, counsel's argument does not take the place of data. Furthermore, Applicant has not compared the closest prior art. Specifically, Applicant has not tested the laminate of Ohmura after it has been subjected to temperatures of 400°C (as in the examples of Ohmura). Furthermore, the data in the specification does

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not agree in scope with the claims. It has not been shown that all polymers of formulas I and II require drying temperatures above 200°C to reach the claimed "insoluble content."

Applicant argues that the polymers taught by Frost are also not cured. The examiner respectfully disagrees. Specifically, Frost teaches that the polymer should be cured (col 4, lines 34+). Thus, applicant's arguments are not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-

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0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*W-RK*

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Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700